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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/542,048	12/06/2005	Tsuyoshi Masuda	Q89074	6247

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EXAMINER	
MESH, GENNADIY	

ART UNIT	PAPER NUMBER
1796	

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05/22/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/542,048	MASUDA ET AL.	
	Examiner	Art Unit	
	GENNADIY MESH	1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *29 April 2008*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,2 and 5 -10* is/are pending in the application.

4a) Of the above claim(s) *3,4 and 11-17* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,2 and 5 -10* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

Applicant's amendment filed on April 29, 2008 is acknowledged.

Per Applicant request Claims 8and 9 now will be considered as Elected: due to an inadvertent error made by Applicant Claims 8 and 9 were withdrawn previously. However, subject matter claimed in Claims 8 and 9 will be treated as a "new issue" or new amendments to claims.

Terminal Disclaimer

The terminal disclaimer filed on April 29, 2008 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of US Patents 7,087,229 and 7,189,797 has been reviewed and is accepted. The terminal disclaimer has been recorded. Therefore, ODP rejection over US Patents 7,087,229 and 7,189,797 has been overcome.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

1. Claims 1,2 and 5 - 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nakamura et al. (JP Application 61-154204 or Publication 63-12737) cited by Applicant) in view of Yamamoto (US 6,593,447) and in further view of Kowallik et al.(4,254,018).

Regarding Claim 1 Nakamura discloses polyester yarn, having flat cross-sectional (modified) profile – see claims.

Nakamura does not disclose specific method for polymerization of the polyester nor specific catalyst claimed by Applicant in Claim 1.

However, Yamamoto teach, that polyester fiber(see lines 16-22,column 1) can be obtain from polyester produced by polycondensation process, wherein catalyst comprising reaction product of :

i) titanium compound - see formula (I) of abstract - this compound is substantially same as compound (IV) of Claim 1

ii) aromatic polyfunctional carboxylic acid – see formula (II) of abstract – this component same as component (II) of Claim 1

iii) phosphorus compound - see Formula (III) of abstract- this component same as component (V) of Claim 1.

Yamamoto further teach that this catalytic system allowed to obtain **polyester with good color tone and excellent melt stability** compare for example with polyester obtained by antimony comprising catalyst (see lines 46-61,column 1 and 50 – 57,column 2).

Therefore, it would have been obvious for ordinary skill in the art at the time of the invention to use polyester, obtain by process catalyzed by titanium compound as it taught by Yamamoto, for production of polyester fibers disclosed by Nakamura .

Note, that Yamamoto silent regarding use of alternative phosphorus compound (see Formula (III)) claimed by applicant in Claim 1.

However, use of this specific phosphorus compound (Formula (III) in Claim 1) for polyester polymerization and yarn production is well known in the art.

Kowallik teach(see abstract) that phosphonate compound of chemical Formula (III) can be used as heat stabilizing agent during polyester polymerization process and capable not only suppress discoloration, but also prevent **formation of coarse precipitates that can clog spinning dyes during fiber production.**

Therefore, it would have been obvious for ordinary skill in the art at the time of the invention to obtain polyester fiber disclosed by Nakamura in view of Yamamoto, wherein heat stabilizing compound is the specific compound (compound of Formula III in claim 1) taught by Kowallik in order prevent **formation of coarse precipitates that can clog spinning dyes during fiber production.**

Regarding limitations of Claim 2 - see Yamamoto, lines 50 – 53,column 6 and lines 29-39,column 5.

Regarding limitations of Claims 5 – see Yamamoto, lines 60-68,column 8 and column 9, lines 1-50.

Regarding limitations of Claim 7 – see Nakamura: claims and drawing (a and b) on page 4.

Regarding limitation of Claim 8 - see Nakamura, claim 1.

Regarding limitation of Claim 9 - see Nakamura, claim 3.

Regarding limitation of Claim 10 - see Nakamura drawing (c) on page 4.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2.1. Claims 1- 5 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-20 of copending Application No. 10/541,574: claims of both Applications significantly overlapping in scope as claimed subject matter drawn to polyester fibers, obtain by the same polymerization process with same catalytic system in both Applications.

This is a provisional obviousness-type double patenting rejection.

2.2. Claim 1-5 are directed to an invention not patentably distinct from claims 1-20 of commonly assigned Application No. 10/541,574 as it shown above – see paragraph 4.1.

2.3. The U.S. Patent and Trademark Office normally will not institute an interference between applications or a patent and an application of common ownership (see MPEP Chapter 2300).

Commonly assigned instant Application and Application No. 10/541,574, discussed above, would form the basis for a rejection of the noted claims under 35 U.S.C. 103(a) if the commonly assigned case qualifies as prior art under 35 U.S.C. 102(e), (f) or (g) and the conflicting inventions were not commonly owned at the time the invention in this application was made. In order for the examiner to resolve this issue, the assignee can, under 35 U.S.C. 103(c) and 37 CFR 1.78(c), either show that the conflicting inventions were commonly owned at the time the invention in this application was made, or name the prior inventor of the conflicting subject matter.

A showing that the inventions were commonly owned at the time the invention in this application was made will preclude a rejection under 35 U.S.C. 103(a) based upon the commonly assigned case as a reference under 35 U.S.C. 102(f) or (g), or 35 U.S.C. 102(e) for applications pending on or after December 10, 2004.

3.1. Claims 1- 5 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1- 15 of copending Application No. 10/535,419: claims of both Applications significantly overlapping in scope as claimed subject matter drawn to polyester fibers, obtain by the same polymerization process with same catalytic system in both Applications.

This is a provisional obviousness-type double patenting rejection.

3.2. Claims 1- 5 directed to an invention not patentably distinct from claims 1- 15 of commonly assigned Application No. 10/535,419 as it was shown above – see paragraph 5.1.

3.3. The U.S. Patent and Trademark Office normally will not institute an interference between applications or a patent and an application of common ownership (see MPEP Chapter 2300).

Commonly assigned instant Application and Application No. 10/535,419, discussed above, would form the basis for a rejection of the noted claims under 35 U.S.C. 103(a) if the commonly assigned case qualifies as prior art under 35 U.S.C. 102(e), (f) or (g) and the conflicting inventions were not commonly owned at the time the invention in this application was made. In order for the examiner to resolve this issue, the assignee can, under 35 U.S.C. 103(c) and 37 CFR 1.78(c), either show that the conflicting inventions were commonly owned at the time the invention in this application was made, or name the prior inventor of the conflicting subject matter.

A showing that the inventions were commonly owned at the time the invention in this application was made will preclude a rejection under 35 U.S.C. 103(a) based upon the commonly assigned case as a reference under 35 U.S.C. 102(f) or (g), or 35 U.S.C. 102(e) for applications pending on or after December 10, 2004.

Response to Arguments

Applicant's arguments filed on April 29,2008 have been fully considered but they are not persuasive.

4. Applicant's arguments regarding Claims 1,2 and 5 - 10 rejected under 35 U.S.C. 103(a) as being unpatentable over Nakamura et al. (JP Application 61-154204 or Publication 63-12737) cited by Applicant) in view of Yamamoto (US 6,593,447) and in further view of Kowallik et al.(4,254,018) based on alleged deficiency of each individual reference.

Note, that in response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.,* 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

In this case, combination of references meet all limitations of Claims 1,2 and 5 - 10 and one ordinary skill in the art would be motivated to obtain polyester fiber disclosed by Nakamura in view of Yamamoto, wherein heat stabilizing compound is the specific compound (compound of Formula **III** in claim 1) taught by Kowallik in order prevent **formation of coarse precipitates that can clog spinning dyes during fiber production**. (see rejection paragraph 1)

Also, note that Nakamura discloses limitations of Claim 8 and 9 - for this reason Claims 8 and 9 would be rejected in previous Office action if they would be elected by Applicant.

5. Provisional ODP rejection is maintained for the Record.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to GENNADIY MESH whose telephone number is (571)272-2901. The examiner can normally be reached on 10 a.m - 6 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on (571) 272 1119. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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